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1636
JTW

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Thomas D. Reed, et al : Paper No:
Serial No. 10/018,697 : Group Art Unit: 1636
Filed: December 13, 2001 : Examiner: M. Burkhart
For: **AGENT AND PROCESS FOR ISOLATION OF EXTRA-
CHROMOSOMAL NUCLEIC ACIDS**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated October 20, 2004, Applicants submit the following:

Election/Restrictions

Restriction is now required under 35U.S.C. 121 and 372. The Examiner contends that the present application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1:

Group I, claim(s) 1-37, drawn to a method of isolating extrachromosomal nucleic acids by: removal of chromosomal nucleic acid; precipitation of extrachromosomal nucleic acid with a chaotropic solution; and recovery of the nucleic acid; and

Group II, claim(s) 38-51, drawn to a method of isolating nucleic acids by partial purification with a retaining means (*i.e.* a gel) followed by precipitation and recovery.

Applicants respectfully traverse this restriction requirement.

First, all of the claims in the present application involve the same basic ingredients and steps. Second, MPEP §803 states that even if an application includes several independent or distinct inventions, they should all be considered together in a single prosecution if that can be done without placing a serious burden on the Examiner. Even if it is assumed that the claims of the present invention cover more than one distinct invention, they should all be considered together since largely the same art would have to be searched for each claim. Therefore, considering all claims together would not place a serious burden on the Examiner.

Additionally, the methods for Groups I and II, at least to a significant extent, will overlap with the references that would have to be searched for the other group. Thus, searching the claims of Group I and II together should not place an undue burden on the Examiner.

In addition, the Examiner has not shown that the claims of Groups I and II would be classified in a different class and subclass. In this case, applicants request that, even if they were to represent independent or distinct inventions, the claims of Groups I and II should be considered together based on MPEP §803. In regards to Groups I and II of the present case, the compositions and methods of each group are so inextricably intertwined as to require the same search and review by the Examiner.

For that reason, it is requested that the Examiner withdraw the restriction requirement for these two groups and examine all claims of Groups I and II currently pending in the current application together.

However, in the event the Examiner maintains the restriction requirement, **Applicants elect the claims of Group I** for further prosecution in the present application, reserving the right to prosecute the remaining claims in a separate divisional application.

Any deficiency or overpayment regarding this petition should be charged or credited to Deposit Account No. 06-2226.

Serial No. 10/018,697

The Commissioner for Patents is hereby authorized to charge payment of the following fees during the pendency of this application or credit any overpayment to Frost Brown Todd LLC, Account No. 06-2226:

Any additional filing fees required by 37 CFR 1.16 and/or 37 CFR 1.492;

Any deficiency in the patent application processing fees as required by 37 CFR 1.17;

Any deficiency in the issue fee as set forth in 37 CFR 1.18.

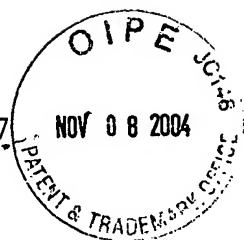
The above authorization does not include permission to charge payment of the entire issue fee to our account upon issuance of a notice of allowance.

A duplicate of this transmittal letter is enclosed for any of these additional charges or credits.

It is respectfully requested that the present application, with the claims provided herewith, be examined and issued as a U.S. patent. Applicants' undersigned attorney has made a good faith effort to be responsive to the restriction requirement made in the Office Action dated May 26, 2004.

If the Examiner would like to discuss the restriction requirement or to have applicants provide any clarification of its terms, he is invited to contact Applicant's undersigned attorney at the phone number given below.

Serial No. 10/018,697



Respectfully submitted,

THOMAS D. REED, *et al.*

By

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, this 3rd day of November, 2004.